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No. 82-1075

IN THE

Supreme Court of the United States

OCTOBER TERM, 1982

CPG PRODUCTS CORP. and GENERAL MILLS
FUN GROUP, INC.

Petitioners,

v.

ANTI-MONOPOLY, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE COURT OF APPEALS FOR THE NINTH CIRCUIT

**MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE*
AND
BRIEF FOR THE COMMITTEE ON TRADEMARKS
AND UNFAIR COMPETITION OF THE
ASSOCIATION OF THE BAR OF THE CITY OF NEW YORK,
*AMICUS CURIAE***

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New York, Amicus Curiae

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MOTION OF THE COMMITTEE ON TRADEMARKS AND
UNFAIR COMPETITION OF THE ASSOCIATION OF
THE BAR OF THE CITY OF NEW YORK FOR LEAVE
TO FILE A BRIEF AMICUS CURIAE

The Committee on Trademarks and Un-
fair Competition of the Association of
the Bar of the City of New York respect-
fully moves pursuant to Rule 36 of this
Court for leave to file a brief amicus
curiae in support of the petition for a
writ of certiorari to the Ninth Circuit.
Petitioners' consent to the filing of
this brief is on file with the Clerk of

this Court. Respondent has denied the requested consent.

The Committee on Trademarks and Unfair Competition of the Association of the Bar of the City of New York (the "Committee") monitors and reports on developments in the law of trademarks and unfair competition. The Committee endeavors to educate Association members and to contribute to these developments. While, in their individual practices, Committee members represent clients with specific economic interests and must advocate positions supporting these interests, sitting as a Committee the members attempt to analyze issues of trademark and unfair competition law objectively, in order to reach conclusions which fairly balance and promote the interests both of trademark proprietors and of consumers. Thus, while Petitioners will necessarily con-

centrate on the peculiar facts and merits of this case, the Committee at this time takes no position with respect to the ultimate outcome of this controversy, and instead analyzes the more far-reaching consequences of the decision for which review is sought.

This cases poses the question: How does a court determine whether a term which has served to identify a product's source has now come to signify to a majority of the public only a product? The case therefore poses a question of first impression for this Court.¹ This

¹ This Court's decision in Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938) involved a term which this Court ruled was generic ab initio. In the present case, the district court found, and the Ninth Circuit agreed, that the term at issue did originally function as a trademark, Anti-Monopoly v. General Mills Fun Group, 515 F. Supp. 448, 451-52 (N.D. Cal. 1981); Anti-Monopoly, Inc. v. General Mills Fun Group, Inc., 684 F.2d 1316, 1321 (9th Cir. 1982).

question is of tremendous concern to trademark proprietors and consumers generally, for once a court determines that a trademark has ceased to indicate source and has therefore become a generic or common descriptive name for a product, the trademark proprietor may no longer assert exclusive rights in the term, and the consuming public may no longer rely on that term as a guarantee that the product bearing that term derives from only one source. If a court's analysis in making this determination is incorrect or misconceived, then, consumers who believe that the term at issue does in fact signify a single source of origin, and therefore serves to symbolize a certain quality and consistency, will be misled when other producers are permitted to appropriate the term. Similarly, the proprietor of a term which has improperly

been ruled generic will lose the substantial goodwill built up in that term.

The Committee believes the decision of the Court of Appeals for the Ninth Circuit, holding MONOPOLY generic, derives from a gross misconception of trademark law and policy, and advances a rationale and standard which threaten wholesale invalidation of existing trademarks. The manner in which the Ninth Circuit disposed of the issue of genericness undermines well-established trademark principles, and contravenes the public interest in protection of recognized symbols of business goodwill. The Committee believes that its brief will assist the Court by setting in a broader context the problems Petitioners present.

The Committee therefore respectfully requests that this motion be granted.

Dated: New York, New York
January 10, 1983

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OF THE PETITION FOR A WRIT OF
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FOR THE NINTH CIRCUIT

This brief is submitted on behalf of
the Committee on Trademarks and Unfair
Competition of the Association of the
Bar of the City of New York, as amicus
curiae, together with a Motion For
Leave to File a Brief Amicus Curiae,
consent to the filing of such a brief

having been denied by Respondent.

INTEREST OF THE AMICUS CURIAE

The Committee on Trademarks and Unfair Competition of the Association of the Bar of the City of New York (the "Committee") has set forth its interest in the accompanying Motion for Leave to File a Brief Amicus Curiae. For the reasons set forth in that Motion, the Committee believes that this case presents questions of extraordinary importance to the appropriate interpretation and application of trademark law, and accordingly urges the Court to grant the Petition for Certiorari.

STATEMENT

Protection of trademark rights promotes two important interests. Because a trademark identifies and distinguishes the goods of one producer,¹ it

¹ See 15 U.S.C. §1127 (defining "trademark"). See generally 1 T. McCarthy TRADEMARKS AND UNFAIR COMPETITION, § 3:2 (1973).

symbolizes a producer's trade identity and secures its good will. The trademark also assures the purchasing public that it is in fact acquiring the goods it believes to emanate from a single source which has come to be identified by the mark. Protection of trademark rights thus protects the public from confusion created by those who would appropriate the recognized symbol of another's good will. The public need not know the name of the producer or manufacturer behind the trademark, so long as it believes that the goods emanate from a single, if anonymous, source.²

. A term which commonly identifies the nature or class of the goods, but which fails to inform the public that the goods emanate from a single source is

² See generally McCarthy, supra, § 3:3 (B).

not a trademark. Rather, the term is a "common descriptive name", or "generic".³ For example, "car" is a generic term. It is the term commonly used to identify a class of goods, and neither distinguishes among the class, nor identifies a source for the goods. A term which denotes to the public both goods and source, however, is not generic. For example, the term ROLLS ROYCE evokes not merely a car, but a car of particular appearance, quality and prestige, which the public associates uniquely with one producer.⁴ Nonetheless, ROLLS ROYCE

³ 15 U.S.C. § 1065(4) provides that registration of a mark may be cancelled if the mark is the "common descriptive name of an article or substance". Courts have used the rubric "generic" synonymously with "common descriptive name". See, e.g., Anti-Monopoly, Inc. v. General Mills Fun Group, 611 F.2d 296, 301 (9th Cir. 1979) (Anti-Monopoly II); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).

⁴ See, e.g., Rolls Royce, Inc. v. Custom Cloud, Inc., 190 U.S.P.Q. 80 (S.D.N.Y. 1976).

remains the trademark, and "car" remains the generic term. For a term to be generic, the public must primarily perceive it as an identification of the class or nature of the goods, rather than as an identification of the goods' source.⁵

The same principle applies when only one producer is the source of goods which are determined to comprise a

⁵ See, e.g., Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 118 (1938). See also Council of Better Business Bureaus v. Better Business Bureau of So. Fla., 200 U.S.P.Q. 282, 290-91 (S.D.Fla. 1978) (service mark) ("The mere fact that the Mark may have some significance to the public as indicating the nature of the goods or services is not fatal to its existence as a valid mark. . . . The public's ability to associate the services offered by a Better Business Bureau with its name, is recognition of the strong secondary meaning which has attached to the Better Business Bureau Name and Mark, not proof that the mark is generic.")

unique class. For example, only one company produces a supersonic jet transport designed for commercial passengers. Nonetheless, while that company's trademark, CONCORDE, certainly evokes an image of the airplane, it also denotes the producer, and therefore is a legitimate trademark. By contrast, the term "commercial passenger supersonic jet transport" is simply the name of a kind of airplane, it does not prompt any source-identification, and therefore is the generic name of the article. Thus, whether the class of goods derives from only one, or from many sources, the question remains the same: Is the "major significance" to the public of the term at issue as a trademark, or merely as the generic name of the goods?⁶ Majority understanding of the

⁶ King-Seeley Thermos Co. v. Aladdin Indus., Inc., 321 F.2d 577, 579 (2d Cir. 1963).

nature of the term determines its major significance.⁷

SUMMARY OF ARGUMENT

The Ninth Circuit's opinions rest upon egregiously erroneous interpretations of trademark law. First, in determining the relevant class of goods to which the game bearing the MONOPOLY mark belongs, the court improperly denominated the game a class unto itself. Second, the court incorrectly held public motivation for purchasing a product the guiding standard for assessing trademark validity.

The Committee believes the Ninth Circuit's decision, if allowed to stand, would result in invalidation of virtually all trademarks, for virtually all products, whether "unique" or in

⁷ See generally McCarthy, supra, § 12:2(C).

competition with similar goods. The test of trademark validity is not, as the Ninth Circuit maintains: Do consumers buy a product primarily because they know and like its producer?

Rather, the prevailing test is: "What do buyers understand by the word for whose use the parties are contending?"

Bayer Drug Co., Inc. v. United Drug Co., 272 F. 505, 509 (S.D.N.Y. 1921)

(L. Hand, J.).⁸ Under the Ninth Cir-

⁸ Accord, Surgicenters of America, Inc. v. Medical Dental Surgeries Co., 601 F.2d 1011, 1016 (9th Cir. 1979) ("in making the sometimes elusive determination of genericness courts have consistently followed the test stated by Judge Learned Hand in Bayer Drug Co., Inc. v. United Drug Co...."). See also Dictaphone Corp. v. Dictamatic Corp., 199 U.S.P.Q. 437 (D. Ore. 1978) (colloquial misuse by the public of a trademark as shorthand for a product category does not mean that the trademark has become generic; the test is whether, despite this misuse, the public still understands the mark to refer to a single source, rather than to a class of goods deriving from any number of sources); E.I. DuPont de Nemours v. Yoshida Int'l. Inc., 393 F. Supp. 502 (E.D.N.Y. 1975) (same).

cuit's anomalous approach, no amount of public recognition that the term symbolizes a single source (and therefore is a trademark) will suffice if the public does not also manifest tender sentiments toward that single source. The Ninth Circuit's unwarranted interpolation would doom legitimate trademarks, and thus would foster consumer confusion by permitting widespread appropriation of terms which the public in fact perceives as unique to particular producers.

ARGUMENT

THE NINTH CIRCUIT'S OPINIONS MIS-
CONCEIVE THE GENERICNESS DOCTRINE
AND PROMULGATE A STANDARD WHICH
WOULD CANCEL MOST RECOGNIZED TRADE
MARKS

- A. The Ninth Circuit's Relegation
of a Distinctive Game to a Discrete

Class Jeopardizes the Trademark of
Virtually Any Product Whose
Appearance, Performance, or
Characteristics Are in Any Way
Distinctive

The district court rejected Anti-Monopoly's genericness claim on the ground that MONOPOLY was not generic for, or synonymous with, the class of board games involving real estate trading. Anti-Monopoly v. General Mills Fun Group, 195 U.S.P.Q. 634, 638 (N.D. Cal. 1977) (Anti-Monopoly I). The Ninth Circuit determined that the MONOPOLY game, due to its special qualities, was a "unique game", and constituted its own "product category". Anti-Monopoly II, 611 F.2d 296, 305 (9th Cir. 1979).⁹

⁹ The Ninth Circuit also denominated a "product category" or class of goods a "genus"; and one producer's, essentially fungible, version of the product, a "species". Thus, under this terminology, a term identifying a

The Committee urges that this classification was fundamentally misconceived. As Judge Nies of the United States Court of Customs and Patent Appeals (now the Court of Appeals for the Federal Circuit) recently stated:

No principle of trademark law requires the imposition of penalties for originality, creativeness, attractiveness, or uniqueness of one's product or requires a holding that the name arbitrarily selected to identify the product . . . cannot also function as an identification of source. . . . The application of the truism [that a trademark functions to indicate the source of the goods, not the goods themselves]

[FOOTNOTE 9 CONTINUED FROM LAST PAGE]

"genus" is generic, while a term identifying a "species" may be a trademark. Amicus believes the attempt to impose a Linnean classification system onto trademark analysis is more confusing than illuminating. Application of these biological rubrics does not advance analysis; rather, it tends to afford an awkward and misleading restatement of the problem of determining whether the term at issue identifies a class of goods which may originate with any number of sources, or whether the term identifies the goods of a single source.

depends upon how the public perceives and uses the asserted mark, as well as upon accepted business practices. It becomes sophistry if the generic nature of a word or name depends upon how broadly or narrowly . . . a court defines a "kind" o[r] "class" of goods.

In re D.C. Comics, Inc., 215 U.S.P.Q. 394, 403-04 (CCPA 1982) (Nies, J., concurring).¹⁰

The MONOPOLY game may be the only real estate trading board game to be played a particular way, or to have a

¹⁰ In D.C. Comics, the court rejected the Trademark Trial and Appeal Board's view that drawings of Superman, Batman, and Joker could not be registered as trademarks for Superman, Batman, and Joker dolls because the drawings were descriptive of the products. Like Judge Nies, the majority found no merit in the Board's attempt to subdivide Superman, Batman and Joker into their own classes. "[A]ppellant cannot be considered to have created a new product category, the rubric of which (for example, 'Superman dolls') should remain available for all to employ in commerce, simply by having originated and promoted certain unique characters and products related to them." 215 U.S.P.Q. at 397.

particular appearance, but it is no more a class unto itself than is any product whose attributes distinguish it in some way from similar products. For example, only ROLLS ROYCE cars combine certain design and engineering features, but a ROLLS ROYCE is still a car. Under the Ninth Circuit's "sophistic" approach, however, ROLLS ROYCE, or any other trademark of a distinctive product, would be treated as the name of a separate product category, and hence would incur a substantial risk of being held a "common descriptive name".

B. The Ninth Circuit's "Motivation" Test Does Not Reveal Trademark Significance, and Would Invalidate Most Trademarks

After confining the MONOPOLY game to its own class, the Ninth Circuit remanded to the district court to determine whether the primary significance of the term to the public was as an indication

of source, or merely as an identification of a unique game. The district court reviewed a survey produced by Anti-Monopoly which identified MONOPOLY as a Parker Brothers game, and then inquired whether the interviewees would purchase MONOPOLY "primarily because I like Parker Brothers' products" or "primarily because I am interested in playing 'Monopoly'. I don't much care who makes it." See Anti-Monopoly III, 515 F.Supp. 448, 453 n.5 (N.D. Cal. 1981). According to the survey, only one-third of the public would purchase the MONOPOLY game because it entertained warm feelings toward Parker Brothers. The district court rejected this survey: "[M]ost consumers, indeed an overwhelming proportion thereof, purchase any given product not out of good will or affection for the producer, but because they want or favor the product. . . . Moreover,

the 'primary significance' of a trademark corresponds more to the recognition of a mark as the brand name of a particular producer than it does to the reason for purchasing." Id. at 454.

Stating that "[t]he dispositive issue hence is not why consumers buy MONOPOLY sets, but rather, what is their understanding of the name MONOPOLY", id. (emphasis in original), the district court credited a survey which explained the difference between a "common name" and a "brand name", and then asked interviewees to indicate which of a list of names were common names and which were brand names. 63% identified MONOPOLY as a brand name. Moreover, 55% correctly identified Parker Brothers as the producer. Based on this evidence, the court concluded that consumers were aware that MONOPOLY denotes source, and further, that this awareness extended to

the actual identity of the source. Thus, the court held, the name MONOPOLY in the public eye means more than a popular game; it means a game by a particular and known producer, and therefore the term enjoys primary trademark significance. Id.

The Ninth Circuit rejected the district court's treatment of the survey evidence. The court observed that the "brand name" survey defined a brand name as the name of a product made by one company. MONOPOLY, the court stated, is made by only one company, and therefore by definition would have to be a brand name. Thus, the Ninth Circuit held, this survey could not reveal trademark significance. Anti-Monopoly IV, 684 F.2d 1316, 1323 (9th Cir. 1982). Instead, the Ninth Circuit embraced the motivation survey. The court believed that this sur-

vey separation of "product related" reasons for a purchase from "source related" reasons gauged the significance the consumer attached to the term's source-denoting characteristics. Id. at 1325-26.

The Committee urges that consumer motivation has nothing to do with trademark significance. A term is a trademark if the public perceives it as a symbol that the goods come from a single source.¹¹ The public need not care who the single source is.¹² It suffices that the public believe there to be a single source. Were motivation the proper test, most trademarks would be in jeopardy. For example, if a majority of consumers buy a particular brand name detergent because they believe it cleans clothes

¹¹ See generally cases cited supra note 8; McCarthy, supra §3:3(B).

¹² See generally McCarthy, supra, §3:3(B).

better, this would be a "product related" reason for the purchase. Under the Ninth Circuit's analysis, the brand name would be held a generic term for "superior detergent".

Indeed, following its faulty logic, the Ninth Circuit observed that the failure of TIDE [whose 89% score on the "brand name" test makes it one of the most popularly recognized trademarks, see Appellees' opening br. in Anti-Monopoly IV, at 15] to score over 13% on the motivation test suggested that "Procter and Gamble might have cause for alarm". Anti-Monopoly IV, 684 F.2d at 1326. Since 60% of the surveyed public stated it would buy TIDE because it does a good job, and 68% stated it would buy TIDE primarily because it likes the detergent, the court stated, "We suspect these results tend to show that the general public regards 'Tide'

as the name of a particular detergent, having particular qualities, rather than as one producer's brand name for the same detergent which is available from a variety of sources." Id.

According to the Ninth Circuit, it appears: (1) TIDE, as a good quality detergent, is, like MONOPOLY, in a product category of its own; (2) the public's selection of "product related" reasons for buying TIDE (it does a good job) means that the name TIDE is generic.

The Committee agrees with the Ninth Circuit to this extent: application of the motivation test would give Procter & Gamble -- or any other trademark proprietor -- cause for alarm. The Committee observes, however, that the court's acknowledgement of the test's inexorable logic should have led to a realization that a test likely

to invalidate virtually any trademark (including the strongest) to which it is applied cannot be a legitimate gauge of trademark validity.

The Ninth Circuit's attempt to separate "product related" from "source related" reasons for a purchase ignores, or rather, severs, the essential link the consumer makes between the "product related" qualities he seeks, and a single source. As Justice Frankfurter stated:

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same -- to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it

appears.

Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 316 U.S. 203, 205 (1942). Under the Ninth Circuit's approach, however, the ability of a trademark to alert and draw the consumer to desirable "product related" qualities is fatal unless the mark also, and primarily, inspires affection for the source behind the product.

Often, however, the public does not even know the name of the source behind the product. For example, X Company may be the producer of Y Brand detergent, but the public may simply identify the source of Y Brand detergent as the "single anonymous source", "the people who make Y". Under the well-established "single anonymous source" rule, so long as the public believes the term claimed as a trademark to refer exclusively to a single source, "the

'source' identified by a trademark need not be known by name to the buyer. It may be anonymous in the sense that the buyer does not know, or care about, the name of the corporation that made the product, or the name of the corporation which distributes it."¹³ Under the Ninth Circuit's approach, however, the public's ignorance of the actual manufacturer, or its parent company, would doom a trademark: a public which does not know who the producer is can hardly be expected to buy the product because of the identity of the producer.

Judge Nies has aptly branded the motivation test "an esoteric and extraneous inquiry". Moreover,

[O]nce it is understood that a trademark is functioning to indicate "source" when it

¹³ McCarthy, supra §3:3(b) at 92. See also decisions cited at id. nn. 17, 18.

identifies goods of a particular source, the truism [that a trademark indicates the source of the goods, not merely the goods themselves] then reflects the above-stated objectives of trademark law [to protect business identity and guard against consumer confusion] and the way trademarks actually function in the marketplace. The reason the public is motivated to buy the product, whether because of quality, particular features, source, pleasing design, association with other goods, price, durability, taste, or prestige of ownership, is of concern to market researchers but is legally immaterial to the issue of whether a particular designation is generic. . . . [The motivation] rationale ignores the reality that the primary objective of purchasers is to obtain particular goods, not to seek out particular sources or producers, as such. Motivation does not change a descriptive term which has acquired distinctiveness or any arbitrary word, name, symbol or device into a generic designation. The correct inquiry is whether the public no longer associates what was a trademark with that single source.

In re D.C. Comics, supra 215 U.S.P.Q. at 404 (Nies, J. concurring) (emphasis in original).

CONCLUSION

The petition for a writ of certiorari

to the Ninth Circuit should be granted.

Dated: New York, New York
January 10, 1983

Respectfully Submitted,

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